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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,336	12/28/2001	Gopinathan K. Menon	680.0049USU	8349

7590 08/17/2004

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EXAMINER

COE, SUSAN D

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/034,336	MENON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Susan D. Coe	1654	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 31-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 31-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/15/04</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 15, 2004 has been entered.
2. Claims 16-30 have been cancelled.
3. Claims 1-15 and 31-46 are currently pending.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. The declaration of Dr. Prakash Kadkade, filed July 15, 2004 has been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by

[www.sabinsa.com/news/June2001.htm](http://www.sabinsa.com/news/June2001.htm).

This reference teaches a skin rejuvenating composition containing coconut water.

7. Claims 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,339,442.

This reference teaches a topical composition that comprises 0.1 to 10% of a Gynostemma extract (see claims 33 and 36). The composition prevents aging (see claim 43) and includes carriers (see columns 7 and 8).

***Claim Rejections - 35 USC § 103***

8. Claims 1-5, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over [www.sabinsa.com/news/June2001.htm](http://www.sabinsa.com/news/June2001.htm).

As stated above, the Sabinsa website teaches a cosmetic that contains coconut water. However, the reference does not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

The reference also does not specifically teach adding all of the additional ingredients in claim 14. However, all of these ingredients are known in the art to be suitable for adding to a topical composition. Therefore, a person of ordinary skill in the art would have been motivated to add these ingredients to the composition taught by the combination of the references.

The reference does not specifically teach formulating the composition in the forms claimed by applicant in claim 15. These forms of administration are well known in the art to be

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acceptable forms for a topical composition. Based on this knowledge, a person of ordinary skill in the art would have had a reasonable expectation that formulating the composition taught by the reference in the claimed forms would be successful. Therefore, an artisan of ordinary skill would have been motivated to formulate the composition taught by the reference in the forms claimed by applicant.

9. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4,339,442.

As stated above, US '442 teaches a cosmetic that contains *Gynostemma*. However, the reference does not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

10. Claims 1-15 and 31-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over [www.sabinsa.com/news/June2001](http://www.sabinsa.com/news/June2001), US Pat. No. 4,339,442, Japanese Pat. Appl. No. 2000128729, and Japanese Pat. Appl. No. 200014498 A.

As discussed above, the Sabinsa website teaches using coconut water to improve the appearance of the skin.

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As discussed above, US '442 teaches using *Gynostemma* to improve the appearance of the skin.

JP '729 teaches a cosmetic composition that contains *Rhodiola*.

JP '498 teaches a cosmetic composition that contains neem extract.

Applicant's claims are drawn to numerous possible combinations of these four ingredients. Each of these references teaches using *Gynostemma*, *Rhodiola*, coconut water, and neem extract to improve the skin. These references show that it was well known in the art at the time of the invention to use the claimed ingredients in skin care compositions. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that these substances are used in skin care compositions, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating a skin care composition. Therefore, the artisan would have been motivated to combine each of the claimed ingredients with any of the other claimed ingredients to form a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See In re Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

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The references also do not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

The references also do not specifically teach adding all of the additional ingredients in claim 14. However, all of these ingredients are known in the art to be suitable for adding to a topical composition. Therefore, a person of ordinary skill in the art would have been motivated to add these ingredients to the composition taught by the combination of the references.

The references do not specifically teach formulating the composition in the forms claimed by applicant in claim 15. These forms of administration are well known in the art to be acceptable forms for a topical composition. Based on this knowledge, a person of ordinary skill in the art would have had a reasonable expectation that formulating the composition taught by the reference in the claimed forms would be successful. Therefore, an artisan of ordinary skill would have been motivated to formulate the composition taught by the reference in the forms claimed by applicant.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over

[www.sabinsa.com/news/June2001](http://www.sabinsa.com/news/June2001), US Pat. No. 4,339,442, Japanese Pat. Appl. No. 2000128729,

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and Japanese Pat. Appl. No. 200014498 A as applied to claims 1-15 and 31-46 above, and further in view of US Pat. No. 5,698,423.


As stated above, the Sabinsa website, US '442, JP '729, and JP '498 together teach the claimed composition. However, the references do not specifically teach using a neem seed culture in the composition. US '423 teaches that using a neem seed culture to create a pharmaceutical extract is beneficial over using a straight neem seed extract because it eliminates contaminants present in the straight seed extract (see column 4, lines 38-42). Based on the this teaching, a person of ordinary skill in the art would have reasonably expected that the neem composition taught by JP '498 could be improved if it was created in the manner claimed by US '423. Therefore, an artisan of ordinary skill would have been motivated to use a neem seed extract created using a cell culture extract based on the teaching of US '423 that this method of extraction creates a superior product.

12. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Susan D. Coe, Examiner  
August 9, 2004